

Notice of Allowability

Application No.

09/876,577

Applicant(s)

ANDERSON, GLEN J.

Examiner

Art Unit

Yogesh C. Garg

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/28/07 & Telephonic Interview on 4/20/07.
2. ☒ The allowed claim(s) is/are 1,2,4-24,26,28 and 30-34.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

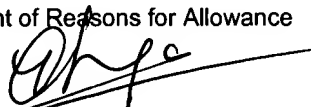
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date 4/23/07.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material

5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 4/23/2007.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


Yogesh C Garg
Primary Examiner
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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/28/2007 has been entered.

Response to Amendment

2. Applicant's amendment received on 3/28/2007 is acknowledged and entered. The applicant has amended claim 9. Claims 3, 25, 27, and 29 are previously canceled. Currently claims 1-2, 4-24, 26, 28, 30-34 are pending for examination.

Response to Arguments

3. Applicant's arguments (see Remarks, pages 9-29) filed on 3/28/2007 concerning rejections of claims 1-2, 4-24, 26, 28, 30-34 under 35 USC 112 first paragraph, 35 USC 102 (e) and 35 USC 103 (a) have been considered and found persuasive. Therefore, rejections of claims 1-2, 4-24, 26, 28, 30-34 under 35 USC 112 first paragraph, 35 USC 102 (e) and 35 USC 103 (a) are withdrawn.

EXAMINER'S AMENDMENT

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Jeffrey A. Proehl on 4/20/2007.

The application has been amended as follows:

In claim 9, delete the term "impressible" in line one and replace it by the term – embedded--.

In claim 13, delete the term "method" in line one and replace it by the term – program of instructions--.

Drawings

5. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figs 5a and 5B are completely illegible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance. This was also discussed in the telephonic interview with Mr. Jeffrey A. Proehl on 4/20/2007.

Allowable Subject Matter

6. Claims 1-2, 4-24, 26, 28, and 30-34 are allowed. Claims 1, 9, 17 and 31 are independent claims and the rest of the claims are their dependencies.

7. The following is an examiner's statement of reasons for allowance:

With reference to claim 1, the prior art of record alone or combined does not fairly suggest or teach or render obvious a method for configuring a build-to-order system accessing a browsing interface via a world wide network, said method comprising, inter alia, the steps integrated as a whole: providing a list of configuration choices presented in a graphical user interface displayed on an information appliance, said list comprising available system elements with which said build-to-order system are configured, receiving a system configuration selection including a combination of at least two system elements of said available system elements selected from said list of configuration choices, and providing a description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection, said description of a function being dependent upon particular capabilities of the combination of said at least two system elements included in said system configuration selection.

The applicant's arguments filed on 3/28/2007 (see Remarks, pages 12-27) are compelling and persuasive that the prior art of record does not fairly teach or render obvious all the limitations of claim 1 and therefore claim 1 and its dependencies are allowable.

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With regards to claims 9-24, 26, 28, and 30-34, they include language closely parallel to the language of claim 1 and therefore the reasons for allowance for these claims are based on the same rationale as set forth above for claim 1.

8. Discussion of most relevant prior art:

The most relevant prior art is that of Henson (US Patent 6,167,383). Henson teaches a method for configuring a build-to-order system (see at least abstract), comprising: (a) providing a list of configuration choices, said list comprising available system elements with which said build-to-order system are configured, receiving a system configuration selection based on a combination of system elements selected from said list of configuration choices, and (c) providing a description of a function capable of being implemented by each of the selected elements (for these three limitations see at least col.6, lines 18-43 and FIG. 3 [3A, 3B, and 3C]). Note: In Figs. 3 A, 3 B and 3C Henson discloses providing a list of configuration choices in the form of displaying various choices for selecting memory, hard drive, monitor, etc., thereby prompting an user to make selections to configure and order a build-to-order computerized system. While presenting the choices, Henson provides description of functions of individual elements, see Fig. 3A: such as, a larger hard drive provides more storage space for the operating systemmonitors can deliver enhanced resolution and refresh rates, crisp, vibrant imaging and amazing color depth, etc.. Henson further discloses (see col.7, line 57-col.8, line 6) a validation module, which checks and describes if the selected elements are valid or incompatible. But, Henson does not fairly

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suggest or render obvious providing a description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection, said description of a function being dependent upon particular capabilities of the combination of said at least two system elements included in said system configuration selection.

In this regard, the applicant's arguments are compelling and persuasive (see Remarks filed on 3/28/2007:

"As previously noted, claim 1 requires, in part, "providing a description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection, said description of a function being dependent upon particular capabilities of the combination of said at least two system elements included in said system configuration selection". ... Turning first to the "Response to Arguments" portion of the most recent Office Action, In each of these examples given in the Office Action, the statement associated with each of the components is directed solely to the function of that component, and it is noted that any printer is "capable to print the kid's artwork", and any scanner is capable of "turn[trig] hardcopies of photographs and graphics into digital files", so other than describing the basic function of each of these components, there is no description of any function provided by a "particular combination of said at least two system elements comprising said system configuration selection".(see pages 14-16 of Remarks).

..... Turning to Figure 5A (and similarly Figure 5B) of the applicant's disclosure, it is noted that selections (or non-selections) for the various components of the system are shown in a number of dropdown menu-type windows. Further, an overlying window is shown in Figure 5A that sets forth capabilities of the combination of at least two system elements of the system configuration. While some of the capabilities of the system do naturally depend upon the characteristics of the individual component selections for the system, it is submitted that the capabilities of the system displayed in the overlying window are not all directed to the characteristics of one particular component of the configuration, but of

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the functions of the system configuration with the combination of at least two system elements.(see page 17 of Remarks).....

.....Contrast the applicant's disclosure with the disclosure in Figures 3A and 3B of Henson, wherein each "option recommendation 75" is directed only to the particular component with which the recommendation" is associated. Again it is noted(as was noted in applicant's previous responses) that the "recommendations" of Henson do not appear to change depending upon the particular selection made for the component, as the "recommendation" is just that: a general statement of why increasing the quantity of one characteristic is better. It is left up to the user of the purchaser to decide what effect any one selection has on the abilities of the overall system configuration(see page 17 of Remarks).....

.....It is further stated that: This interpretation is further exemplified when Dell provides the description that a particular SELECTION OF SYSTEM ELEMENT is not valid such as in the case of selecting a Video card that it may not be compatible with a windows NT operating system. The system both in Henson and in the applicant's disclosure, see Figs. 5A and 5B and paragraph 0018 of the PG--PUB 2002/0188519 A1 of the applicant's application works on the same basis that is a software analyzes the system configuration selection and provide a description of a function capable of being implemented by two system elements together. However, simply because the webpage depicted in Henson alerts the customer to a potential conflict between a component and operating system software does not equate to a "description of a function capable of being implemented with the combination of at least two system elements". To the contrary, this alert to a potential conflict between component and software is a statement of dysfunction, not of any function. The failure of the system to function with a particular configuration is not a "description of a function" as required by claim 1. While this software conflict information might be helpful to a customer, it certainly does not help a customer compare the relative advantages of the functions of system configurations with different combinations of system elements (see pages 21-22 of Remarks).....

..... It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Henson, Tuzhilin, and Roberts set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 9, 17 and 31. Further, the claims

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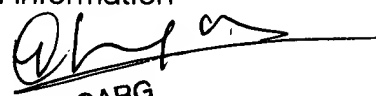
that depend from claims 1, 9, 17 and 31, also include the requirements discussed above and therefore are also submitted to be in condition for allowance(see page 27 of Remarks). "

9. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


YOGESH C. GARG
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

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A handwritten signature in black ink, appearing to read 'Yogesh C. Garg', is written over a horizontal line.

Yogesh C. Garg
Primary Examiner
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YCG

4/23/2007175